

REMARKS

The applicant has carefully considered the official action dated May 9, 2005, and the references cited therein. Claims 1-34 are pending in this application. In the official action, claims 1-15 were allowed and, thus, those claims will not be discussed further herein. Claims 18 and 23 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and claim 26 was rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Additionally, claims 16, 21, 25, 27, 28, 31, 32, and 34 were rejected under 35 U.S.C. § 103(a) as unpatentable over Osaka et al. in view of Meier, and claims 17-20, 22-24, 26, 29-30, and 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over Osaka et al. in view of Meier and Harris, Jr. et al. By way of this response, the applicant has amended claims 26-28, 30, and 31 to clarify the scope of protection sought. No new matter has been added. In view of the foregoing amendments and the following remarks, the applicant respectfully traverses the rejections.

The applicant respectfully submits that claims 18 and 23 comply with the written description requirement set forth under 35 U.S.C. § 112, first paragraph. Each of the claims 18 and 23 recites signatures having a backbone and a printer that applies a printed message perpendicular to the backbone. Support for claims 18 and 23 can be found at column 2, lines 37-41 of U.S. Patent 6,257,566, on which the instant reissue application is based.

“Each of the selected signatures delivered from the feeder system includes a backbone and a blank reserved portion, and a printer is positioned to apply a predetermined printed message to the reserved portion of the selected signature, perpendicular to the backbone...” *U.S. Patent 6,257,566*, col. 2, ll. 37-41.

Additionally, the applicant describes printing on reserved portions of signatures in the specification of the instant reissue application at column 4, lines 43-67 and column 5, lines 1-2. Thus, claims 18 and 23 recite subject matter that was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the applicant, at the time the application was filed, had possession of the claimed invention. Accordingly, the applicant respectfully submits that claims 18 and 23 comply with the written description requirement set forth under 35 U.S.C. § 112, first paragraph, and respectfully requests withdrawal of the § 112, first paragraph, rejection of these claims.

The applicant respectfully submits that claim 26, as amended, complies with 35 U.S.C. § 112, second paragraph. Specifically, claim 26 now recites, “wherein the feed conveyor has an output end, and a printer is positioned adjacent the output end of the feed conveyor.” Accordingly, the applicant respectfully requests withdrawal of the § 112, second paragraph, rejection of claim 26.

Now turning to the art rejections, the applicant respectfully submits that claim 16 is allowable over the art of record. Claim 16 is directed to a binding line and recites, *inter-alia*, a feeder system operatively associated with at least one packer box that includes a conveyor, a plurality of feeders, and a controller in communication with the feeders to activate a selected one of the feeders at a time. As the examiner concedes, Osaka et al. do not teach a controller in communication with feeders to activate a selected one of the feeders at a time, as recited in claim 16. To overcome the deficiency in Osaka et al., the examiner looks to Meier and incorrectly alleges that it would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to modify the teachings of Osaka et al. by using a controller that activates a selected one of the feeders at a time. On the contrary, the applicant

respectfully submits that one of ordinary skill in the art would not have been motivated to combine the teachings of Osaka et al. and Meier to make a binding line having each and every element recited in claim 16.

Neither Osaka et al. nor Meier teach or suggest “the desirability of the claimed invention.” MPEP § 2143.01. Osaka et al. teach a binding line to make a mass quantity of identical books (i.e., text books) by feeding a signature from every feeder in the binding line system for each and every signature location on a binding conveyer. Because every feeder of the Osaka et al. binding line feeds unconditionally, the teachings of Osaka et al. obviate the need to have a controller in communication with the feeders to activate a selected one of the feeders at a time. Such a controller in Osaka et al. would be useless because Osaka et al. do not teach or suggest the desirability or the need to have a controller in communication with the feeders to activate a selected one of the feeders at a time. On the contrary, because the Osaka et al. binding line is designed to form all identical books (i.e., the same text book), the Osaka et al. binding line eliminates the need for the Meier controller.

Additionally, the examiner incorrectly contends that one of ordinary skill in the art would modify the Osaka et al. system with the Meier controller for the purpose of determining the degree of filling of a packer box and controlling the supply speeds of the feeder system. Osaka et al. teach a plurality of feeders, each of which always feeds a signature to form a book. In contrast, Meier teaches a system that produces a continuous flow of printed product groups, each of which can comprise a different number of individually supplied printed products. *Meier*, col. 2, ll 48-50. The printed products may be supplied by any one or more of a plurality of storage areas. *Id.*, col. 4, ll. 46-52. Meier teaches that some storage areas may deliver more printed products than others and, thus,

“[t]he minimum necessary degree of filling of the buffer storage area 12 is a function of the frequency with which a specific product is required [to be delivered] in the groups...” *Id.*, col. 3, ll. 45-48. However, the Osaka et al. binding line does not include feeders that feed signatures for some books, but not others. As a result, the Osaka et al. binding line does not require determining the degree of filling of a buffer storage area as taught by Meier or a packer box as suggested by the examiner.

Meier also teaches controlling supply speeds to the buffer storage areas 12 based on the degree of filling of the buffer storage areas 12. Because Osaka et al. lacks the need to determine the degree of filling of a buffer storage area, Osaka et al. would not need to control supply speeds based on the degree of filling of the buffer storage area. The applicant respectfully submits that because the Osaka et al. system does not teach or suggest the desire to determine the degree of filling of a packer box or control the supply speeds of the feeder system, one of ordinary skill in the art would not be motivated to modify the Osaka et al. binding line to use the Meier controller as suggested by the examiner.

Further, Osaka et al. teach cost consciousness in implementing a binding line by reducing the number of process steps, employing efficient bookbinding processes, and avoiding expensive bookbinding machines. *Osaka et al.*, col. 1, ll 59-60 and col. 2, ll. 35-39. Modifying the Osaka et al. binding line to use the Meier controller would contradict the cost conscious binding line teachings of Osaka et al. because such a modification would add unnecessary (e.g., inefficient) and costly equipment and operations to the Osaka et al. binding line.

The applicant respectfully submits that at least for the foregoing reasons, one of ordinary skill in the art would not be motivated to combine the teachings of Osaka et al. and

Meier. Accordingly, the applicant respectfully submits that independent claim 16 and all claims dependent thereon are in condition for allowance.

The applicant respectfully submits that independent claim 21 is also allowable over the art of record for at least some of the reasons set forth above in connection with the remarks for independent claim 16. Accordingly, claim 21 and all claims dependent thereon are also in condition for allowance.

The applicant respectfully submits that independent claim 27 is also allowable over the art of record. Claim 27 is directed to a method and recites, *inter-alia*, operatively connecting a plurality of signature feeders with an associated one of a plurality of packer boxes, supplying each of the signature feeders with a distinct signature, and selectively controlling the feeders to deliver the distinct signatures to the associated one of the packer boxes. The applicant has amended claim 27 to recite “selectively controlling the feeders,” support for which can be found at least at column 2, lines 3-7 and 13-15 of U.S. Patent 6,257,566. The applicant has also amended claims 28 and 30 to recite “selectively controlling” in accordance with claim 27. The applicant respectfully submits that independent claim 27 is allowable over the art of record for at least some of the reasons set forth above in connection with the remarks for independent claim 16. Accordingly, the applicant respectfully submits that claim 27 and all claims dependent thereon are in condition for allowance.

The applicant respectfully submits that independent claim 31 is also allowable over the art of record. Claim 31 is directed to a method and recites, *inter-alia*, a plurality of feeders operatively coupled to a feed conveyor and configured to hold signatures and respond to signals from a controller to cause the feeders to selectively deliver the signatures to the

binding line via the feed conveyor. The applicant has amended claim 31 by amending the element previously reciting "a plurality of feeders operatively ... to cause at least one of the feeders to deliver at least one of the signatures..." to recite "a plurality of feeders ... to cause the feeders to selectively deliver the signatures..." support for which can be found at least at column 2, lines 3-7 and 13-15 of U.S. Patent 6,257,566. The applicant respectfully submits that independent claim 31 is allowable over the art of record for at least some of the reasons set forth above in connection with the remarks for independent claim 16. Accordingly, the applicant respectfully submits that claim 31 and all claims dependent thereon are in condition for allowance.

In view of the foregoing, the applicants respectfully request reconsideration of this application. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark G. Hanley", written over a horizontal line.

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Dated: **October 10, 2005**